



UNITED STATES PATENT AND TRADEMARK OFFICE

35
UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/130,998	08/07/1998	MICHAEL STERN	15818-005000	7187

21971 7590 09/24/2002

WILSON SONSINI GOODRICH & ROSATI
650 PAGE MILL ROAD
PALO ALTO, CA 943041050

EXAMINER

MEINECKE DIAZ, SUSANNA M

ART UNIT

PAPER NUMBER

3623

DATE MAILED: 09/24/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Office Action Summary	Application No.	Applicant(s)
	09/130,998	STERN, MICHAEL
	Examiner Susanna M. Diaz	Art Unit 3623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 15 August 2002.

2a) This action is **FINAL**. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-7,10-14,23,24 and 26 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 1-7,10-14,23,24 and 26 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some * c) None of:

1. Certified copies of the priority documents have been received.

2. Certified copies of the priority documents have been received in Application No. _____.

3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) 34.

4) Interview Summary (PTO-413) Paper No(s) _____.

5) Notice of Informal Patent Application (PTO-152)

6) Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission (IDS, Paper No. 34) filed on August 15, 2002 has been entered.

No amendments or arguments have been made in response to the last office action mailed on June 27, 2002 (Paper No. 32); therefore, all of the same rejections remain pending. Also, Examiner maintains her position, as reflected in the Response to Arguments section (copied from the previous office action).

2. Claims 21, 22, and 27 have been cancelled.

Claims 1-7, 10-14, 23, 24, and 26 remain pending.

Response to Arguments

3. Applicant's arguments filed May 1, 2002 have been fully considered but they are not persuasive.

Applicant argues as follows:

Applicants respectfully traverse the Examiner's statements that Kaplan discloses that said site is disposed a distance from said product to maximize association of said stimulus of said product. For example, Kaplan does not

Application/Control Number: 09/130,998
Art Unit: 3623

Page 3

teach or suggest that a kiosk promoting jazz CDs is located near the jazz section of the music store, and Kaplan does not teach or suggest that a kiosk promoting blues CDs is located near the blues section of the music store.

In contrast, in claim 1 as amended, "at least one of said end clients is disposed a distance from said product to encourage the consumer to purchase said product" and in claim 10 as amended, "at least one of said end clients is disposed a distance from at least one of said multiple products to encourage the consumer to purchase said at least one of said multiple products".

In fact, Kaplan teaches away from this by discussing "any music selection in the store display" (Kaplan, column 6, lines 63-65) (Page 12 of Applicant's response filed on May 1, 2002)

First, the Examiner respectfully submits that the purpose of any advertisement is to encourage the consumer to purchase a particular product from among various available products. Any exposure provided for the music previewed through Kaplan's invention is advertisement for that music; therefore, Kaplan's invention serves to "encourage the consumer to purchase said product" (as recited in claim 1) and "encourage the consumer to purchase said at least one of said multiple products" (as recited in claim 10).

Second, the limitation "disposed at a distance from" is extremely broad in scope. Every physical object is "disposed at a distance from" any other given physical object in the universe. For example, a first object may be disposed at a distance of 5 feet from a second object or the first object may be disposed at a distance of 10,000 miles from the second object. Nevertheless, both objects are "disposed at a distance from" one another. Kaplan's invention may be implemented via a kiosk in a store, a desk top

computer, etc. and therefore provides end clients disposed at a distance from a product(s) to encourage the consumer to purchase said product(s).

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

- (e) the invention was described in–
 - (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or
 - (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

5. Claims 1-6, 10-13, 23, and 26 are rejected under 35 U.S.C. 102(e) as being anticipated by Kaplan (U.S. Patent No. 5,963,916).

Kaplan (U.S. Patent No. 5,963,916) discloses a method of disseminating information concerning a product, both of which are to be perceived by a consumer, said method comprising:

[Claim 1] providing a database that receives files from content providers (Fig. 2; col. 9, lines 16-35 -- Since the store is vending music from content providers, its network management center must somehow receive the music files from the respective content providers);

transmitting said designated files with advertising information and inventory information to end clients remotely disposed with respect to said database, wherein

each end client receives only its designated files and wherein at least one of said end clients is disposed at a distance from said product to encourage the consumer to purchase said product (Figs. 35-42, 46; col. 9, lines 16-35; col. 11, lines 37-39 -- The availability of a product corresponds to inventory information. Furthermore, the mere fact that the kiosk allows users to preview music implies some sort of availability, i.e., inventory, information; col. 12, lines 48-51 -- The selected music is retrieved from the memory at the central location, i.e., the network management center; col. 6, lines 63-64 -- The user is physically in a music store and the kiosk in the store advertises and enables purchase of music);

providing a perceivable stimulus, from said designated files to said consumer, said perceivable stimulus being associated with said product (Figs. 35-57); and

wherein an interactive consumer stimulus initiated by the consumer includes said perceivable stimulus (Figs. 35-57; col. 11, lines 11-20 -- The user interacts with the kiosk to respond to the displays. For example, he/she may preview a product, order a product, respond to survey questions, etc.);

[Claim 2] wherein the perceivable stimulus is repeated multiple times and statistical data are created based at least partly on providing the perceived stimulus (Figs. 35-57 - - The perceivable stimulus may be produced repeatedly; col. 7, line 14 through col. 8, line 17; col. 10, line 66 through col. 11, line 10 -- The perceivable stimulus may be reproduced repeatedly for multiple users);

[Claim 3] wherein transmitting includes forming, from a subportion of said designated files, a distribution database having content data, with said content data

Application/Control Number: 09/130,998
Art Unit: 3623

Page 6

being defined by said perceivable stimulus (Figs. 35-42; col. 12, lines 57-62 -- The user is shown advertisements for different albums and may choose one of them for purchase);

[Claim 4] wherein said perceivable stimulus is dependent upon criteria of an ambient proximate to said product (Figs. 35-42; col. 6, lines 63-64 -- The user is physically in a music store and the kiosk in the store advertises and enables purchase of music);

[Claim 5] wherein said perceivable stimulus is selected from the set consisting of auditory, visual, olfactory and tactile (Figs. 35-42);

[Claim 6] conveying said statistical data to said database (col. 7, line 14 through col. 8, line 17);

[Claim 23] wherein said interactive consumer stimulus is initiated by a consumer scanning a UPC code on said product (col. 14, line 62 through col. 15, line 3).

Kaplan (U.S. Patent No. 5,963,916) discloses a method of disseminating information concerning multiple products, said method comprising:

[Claim 10] receiving files from content providers (Fig. 2; col. 9, lines 16-35 -- Since the store is vending music from content providers, the store must somehow receive the music files from the respective content providers);

assigning at least one attribute for each file and creating designated files for distribution to end clients (col. 12, lines 57-62);

Application/Control Number: 09/130,998
Art Unit: 3623

Page 7

creating a database containing said designated files (col. 9, lines 16-35; col. 12, lines 48-62);

selecting a plurality of end clients (Figs. 40, 46; col. 9, lines 16-35; col. 12, lines 48-62);

transmitting said designated files with advertising information and inventory information to end clients with each end client receiving only its designated files, wherein said end clients are remotely disposed with respect to said database, with subsets of said end clients corresponding to differing products, including transmitting information corresponding to a first of said multiple products to one of said end clients and wherein at least one of said end clients is disposed at a distance from at least one of said multiple products to encourage the consumer to purchase said at least one of said multiple products (Figs. 35-42, 46; col. 9, lines 16-35; col. 11, lines 37-39 -- The availability of a product corresponds to inventory information. Furthermore, the mere fact that the kiosk allows users to preview music implies some sort of availability, i.e., inventory, information; col. 12, lines 48-51 -- The selected music is retrieved from the memory at the central location, i.e., the network management center; col. 6, lines 63-64 -- The user is physically in a music store and the kiosk in the store advertises and enables purchase of music);

providing a perceivable stimulus, from said information corresponding to said first of said products, to a consumer positioned proximate to said one of said end clients, with said perceivable stimulus being associated with said first of said multiple products (Figs. 35-57); and

wherein an interactive consumer stimulus initiated by said consumer includes said perceivable stimulus (Figs. 35-57; col. 11, lines 11-20 -- The user interacts with the kiosk to respond to the displays. For example, he/she may preview a product, order a product, respond to survey questions, etc.);

[Claim 11] wherein said providing step is repeated multiple times and statistical data are defined based at least partly on providing the perceivable stimulus (Figs. 35-57 -- The perceivable stimulus may be produced repeatedly; col. 7, line 14 through col. 8, line 17; col. 10, line 66 through col. 11, line 10 -- The perceivable stimulus may be reproduced repeatedly for multiple users);

[Claim 12] wherein creating further includes accumulating content associated with a subgroup of said multiple products and associating said content with parameters, said parameters including group definitions and date ranges (Figs. 38, 40 -- Users may view music titles by genre, i.e., group definition, or they may choose the category of "new releases" which implies a date range);

[Claim 13] wherein transmitting includes forming a distribution database having a plurality of records, said plurality of records including a subportion of said content and corresponding to a server address, with a subpart of said plurality of end clients being associated with said server address (col. 12, lines 48-62);

[Claim 26] wherein said perceivable stimulus is dependent upon criteria of an ambient proximate to said product (Figs. 35-42; col. 6, lines 63-64 -- The user is physically in a music store and the kiosk in the store advertises and enables purchase of music).

Application/Control Number: 09/130,998
Art Unit: 3623

Page 9

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 7, 14, and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kaplan (U.S. Patent No. 5,963,916), as applied to claims 3 (for claim 7) and 13 (for claims 14 and 24) above.

[Claims 7, 14] Kaplan teaches a music preview embodiment in which an in-store kiosk accesses music information from a remote web site. His web site server is "able to service a plurality of kiosks across the country or across the world" (col. 9, lines 29-30). Kaplan also discloses the "decompression of audio information to the subscriber" (col. 6, lines 11-12), which implies an initial compression of said audio information; however, Kaplan fails to explicitly disclose the distribution of his compressed distribution files to his respective kiosk sites via satellite. The Examiner asserts that satellite communications are old and well-known in the art. As a matter of fact, satellite communications are commonly used to transmit Internet information "across the world." Therefore, the Examiner submits that it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to enable Kaplan's invention to utilize satellite communications to distribute compressed distribution files to the respective end user sites in order to facilitate quick and efficient global communications.

Application/Control Number: 09/130,998
Art Unit: 3623

Page 10

[Claim 24] Kaplan discloses that said interactive consumer stimulus is initiated by a consumer scanning a UPC code on said product (col. 14, line 62 through col. 15, line 3).

Conclusion

8. This is an RCE. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however, event will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susanna M. Diaz whose telephone number is (703) 305-1337. The examiner can normally be reached on Monday-Friday, 9 am - 5 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz can be reached on (703) 305-9643.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (703)308-1113.

Any response to this action should be mailed to:

***Commissioner of Patents and Trademarks
Washington D.C. 20231***

or faxed to:

(703)305-7687 [Official communications; including
After Final communications labeled
"Box AF"]

(703)746-7048 [Informal/Draft communications, labeled
"PROPOSED" or "DRAFT"]

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA, 22202, 7th floor receptionist.

SMD
September 21, 2002


TARIQ R. HAFIZ
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600